

REMARKS

A. Background

Claims 8-23 were pending in the application at the time of the Office Action. All of the pending claims were rejected as being indefinite. All of the pending claims were also rejected as being obvious over cited art. By this response applicant has amended claims 8, 12, 14, 16, and 20-22; and added new claims 24 and 25. As such, claims 8-25 are presented for the Examiner's consideration in light of the following remarks, with claims 8, 20, 22, and 24 being independent.

B. Proposed Claim Amendments

Applicant has herein amended claims 8, 12, 14, 16, and 20-22 to further clarify, more clearly define, and/or broaden the claimed inventions to expedite receiving a notice of allowance. Specifically, claims 8, 12, 14, 16, and 20-22 have been amended to revise language that the Office Action alleges previously invoked 35 U.S.C. 112, sixth paragraph. Other amendments have been made to the claims to remedy formal matters. The amendments to the claims are supported through the specification and drawings. In view of the foregoing, applicant submits that the amendments to the claims do not introduce new matter and entry thereof is respectfully requested.

C. Objection based on Double Patenting

Paragraph 3 of the Office Action maintains the double patenting objection set forth in the prior Office Action, that should claim 8 be found to be allowable, the Examiner will object to claim 20 as being a substantial duplicate thereof. Applicant reiterates that the objection will be addressed, if it is still an issue, once either claim 8 or claim 20 is found to be allowable. Applicant notes that deferring any discussion of the potential future objection does not indicate any admission by the Applicant, implicit or otherwise, concerning the merits of the objection.

D. Rejections based on 35 U.S.C. § 112

Paragraphs 4-6 of the Office Action reject claims 8-23 under 35 USC § 112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Specifically, the Office Action alleges that various claim limitations invoke 35 U.S.C. 112, sixth paragraph, but that the written description fails to disclose

corresponding structure, material, or acts. In response, Applicant has amended claims 8, 12, 14, 16, and 20-22 herein to no longer include “means for” language. In view of the claim amendments made herein to claims 8, 12, 14, 16, and 20-22, Applicant respectfully submits that the indefiniteness rejection of claims 8-23 has been overcome and should be withdrawn.

E. Claim Rejections based on 35 U.S.C. 103

1. Rejection based on Eldering/Eldering2/Eldering3/Kepecs/Hermann combination

Paragraphs 7-8 of the Office Action reject claims 8, 10, 12, 13 and 17-23 under 35 U.S.C. § 103(a) as being obvious over U.S. Publication No. 2004/0148625 to Eldering et al. (“*Eldering*”) in view of U.S. Publication No. 2005/0193410 to Eldering et al. (“*Eldering2*”), U.S. Publication No. 2002/0083443 to Eldering et al. (“*Eldering3*”), U.S. Publication No. 2001/0032128 to Kepecs (“*Kepecs*”) and U.S. Publication No. 2002/0176391 to Hermann et al. (“*Hermann*”). Of the rejected claims, claims 8, 20, and 22 are independent claims. Applicant respectfully traverses these rejections and submits that a *prima facie* case of obviousness has not been established at least because the allegedly obvious combination would not include each and every one of the limitations recited in the rejected claims.

In the Office Action, the Examiner concedes that the allegedly obvious combination of *Eldering*, *Eldering2*, and *Eldering3* fail to teach, suggest, or support “the TTL values of the advertisements set differently for different target destinations such that the advertisements played out at one of the target IP addresses is different than the advertisements played out at the other of the target IP addresses for the same advertisement slot,” as recited in claims 8, 20, and 22. See pages 11, 18, and 25 of the Office Action. This concession is further supported by the Interview Summary Report dated 12/1/2010 and generated by the Examiner in the present application, which also includes *Hermann* in the non-supporting combination. Thus, the Examiner has conceded that an allegedly obvious combination of *Eldering*, *Eldering2*, *Eldering3*, and *Hermann* fail to teach, suggest, or support the above limitation.

The Office Action cites to *Kepecs* to remedy this deficiency. That is, the Office Action asserts that *Kepecs* allegedly teaches the above limitation to attempt to cure the deficiency of the allegedly obvious *Eldering/Eldering2/Eldering3/Hermann* combination. Applicant respectfully disagrees and submits that *Kepecs* does not teach the above limitation.

Kepecs discloses techniques for generating and making incentive offers and promotions to consumers. See paragraph [0008]. In particular, consumer information is collected, e.g., by

using loyalty cards, to determine personal information and buying habits of the consumer. See paragraph [0035]. A marketing system is then used to determine offers to be presented to each consumer based on this information. See paragraph [0040]. An arbiter is used to expire old offers and select new offers to distribute to the consumer. See paragraph [0044]. The offers are distributed via different channels, such as web-based channels, direct mail channels, telephone channels, and others. See paragraph [0045]. *Kepecs* discloses that for web-based channels, emails can be used or the offer can be posted on a web page. See paragraphs [0046] and [0064].

The arbiter determines which offers to send to each consumer using the different channels and when to send or withdraw the offer. If it is determined that the consumer has not viewed or accessed or used the offer in a particular period of time (i.e., an expiration date) for a channel, the arbiter can withdraw the offer. See paragraph [0131]. The offer can then be withdrawn from the other channels even if the expiration dates of the other channels have not been reached. So, for instance, if it is determined that an offer sent to a consumer via direct mail (one channel) was not viewed or accessed or used in a particular number of days, the offer can also be withdrawn from email (another channel) or telephone (another channel).

In the rejection of independent claims 8, 20, and 22, the Office Action cites to paragraph [0131] of *Kepecs* as allegedly disclosing “**the TTL values of the advertisements set differently for different target destinations such that the advertisements played out at one of the target IP addresses is different than the advertisements played out at the other of the target IP addresses for the same advertisement slot,**” recited in claims 8, 20, and 25. However, as discussed above, the cited paragraph of *Kepecs* only discloses that certain offers can be withdrawn across various channels, which *Kepecs* defines as different mediums of dispersion, when an expiration date is met on one of the channels. Thus, the cited paragraph of *Kepecs* does not disclose any sort of “playing out” of advertisements, or the use of TTL in determining different expiration dates. In fact, Applicant can find no mention of TTL or “playing out” of any kind within *Kepecs*. Furthermore, *Kepecs* only discusses sending the offers electronically to a consumer using email; thus, no TTL or “playing out” can even be envisioned. As such, Applicant submits that *Kepecs* does not disclose, suggest, or reasonably support the limitation set forth above. In light of this, even if, *arguendo*, *Kepecs* was combined with the *Eldering/Eldering2/Eldering3/Hermann* combination in the allegedly obvious manner set forth in the Office Action, the combination would not include each and every limitation recited in

independent claims 8, 20, and 22. Accordingly, Applicant respectfully requests that the obviousness rejection with respect to claims 8, 20, and 23 be withdrawn.

Claims 10, 12, 13, 17-19, 21, and 23 depend from claims 8, 20, and 22 and thus incorporate the limitations thereof. As such, applicant submits that claims 10, 12, 13, 17-19, 21, and 23 are distinguished over the cited art for at least the same reasons as discussed above with regard to claims 8, 20, and 22. Accordingly, Applicant respectfully requests that the obviousness rejections with respect to claims 10, 12, 13, 17-19, 21, and 23 also be withdrawn.

Applicant further submits that the rejection is flawed for other reasons. For example, the Office Action alleges that *Hermann* discloses the TTL set at a value approaching zero and cites paragraphs 0021 and 0026 in support. See, e.g., page 12 of the Office Action. However, paragraph 0021 of *Hermann* discloses that if the value of a TTL is approaching zero then that “service list” is omitted from the broadcast because there is no point in broadcasting something that is about to expire. Hence, all *Hermann* discloses is TTL being used in its normal way. It makes no suggestion of actually setting a TTL to zero. In fact, *Hermann* teaches away from setting a TTL to zero because *Hermann* acknowledges that if a TTL is approaching zero it should be omitted from a broadcast.

2. Rejections based on further cited art

Paragraphs 9-13 reject claims 9, 11, and 14-16 as being obvious over the allegedly obvious combination of *Eldering*, *Eldering2*, *Eldering3*, *Kepecs*, and *Hermann*, discussed above, in view of further cited art. Specifically, claim 9 is rejected in view of U.S. Patent No. 6,286,140 to Ivanyi (“*Ivanyi*”); claim 11 is rejected in view of U.S. Publication No. 2002/0124253 to Eyer et al. (“*Eyer*”); claim 14 is rejected in view of U.S. Patent No. 6,698,020 to Zigmond (“*Zigmond*”); claim 15 is rejected in view of U.S. Publication No. 2002/0038455 to Srinivasan et al. (“*Srinivasan*”); and claim 16 is rejected in view of U.S. Publication No. 2004/0111741 to DePietro (“*DePietro*”).

Claims 9, 11, and 14-16 depend from claim 8 and thus incorporate the limitations thereof. As such, applicant submits that claims 9, 11, and 14-16 are distinguished over the cited art for at least the same reasons as discussed above with regard to claim 8. Accordingly, Applicant respectfully requests that the obviousness rejections with respect to claims 9, 11, and 14-16 also be withdrawn.

No other objections or rejections are set forth in the Office Action.

F. New Claims

Applicant submits that new claims 24 and 25 are distinguished over the cited art. For example, new independent claim 24 recites, “the TTL values of the advertisements set differently for different target destinations such that the advertisements played out at one of the target IP addresses is different than the advertisements played out at the other of the target IP addresses for the same advertisement slot.” Applicant submits that none of the cited references, taken individually or combined, discloses this limitation, as discussed herein.

New claim 25 depends from independent claim 24 and thus incorporates the limitations thereof. As such, applicant submits that claim 25 is distinguished over the cited art for at least the same reasons as discussed above regarding claim 24.

G. Conclusion

Applicant notes that this response does not discuss every reason why the claims of the present application are distinguished over the cited art. Most notably, applicant submits that many if not all of the dependent claims are independently distinguishable over the cited art. Applicant has merely submitted those arguments which it considers sufficient to clearly distinguish the claims over the cited art.

In view of the foregoing, applicant respectfully requests the Examiner’s reconsideration and allowance of claims 8-25 as amended and presented herein.

The Commissioner is hereby authorized to charge payment of any of the following fees that may be applicable to this communication, or credit any overpayment, to Deposit Account No. 23-3178: (1) any filing fees required under 37 CFR § 1.16; (2) any patent application and reexamination processing fees under 37 CFR § 1.17; and/or (3) any post issuance fees under 37 CFR § 1.20. In addition, if any additional extension of time is required, which has not otherwise been requested, please consider this a petition therefor and charge any additional fees that may be required to Deposit Account No. 23-3178.

In the event there remains any impediment to allowance of the claims which could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate such an interview with the undersigned.

Dated this 28th day of March, 2011.

Respectfully submitted,

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